



**UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office**

Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
08/813,829	03/06/97	HUGAN	16016.0005

DAVID G PERRYMAN
NEEDLE & ROSENBERG
SUITE 1200 THE CANDLER BLDG
127 PEACHTREE STREET NE
ATLANTA GA 30303-1811

HM12/0125

EXAMINER
CLARK, D

ART UNIT	PAPER NUMBER
1633	3

DATE MAILED: 01/25/99

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

08/813,829

Applicant(s)

Hogan, B. L. M.

Examiner

Deborah Clark

Group Art Unit

1633



☐ Responsive to communication(s) filed on _____

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 0 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-36 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☐ Claim(s) _____ is/are rejected.

☐ Claim(s) _____ is/are objected to.

☒ Claims 1-36 are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

Art Unit: 1633

DETAILED ACTION

Election/Restriction

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-7, 15-19, 23, 24, 27, 28, 30, and 31, drawn to embryonic stem cells, a method of making said embryonic stem cells, and a method of using the embryonic stem cells to contribute to a chimera, classified in class 435, subclass 325.
 - II. Claims 8-9, drawn to primordial germ cells, classified in class 435, subclass 325.
 - III. Claims 10, and 20-22 drawn to embryonic ectoderm cells and a method of using said cells, classified in class 435, subclass 325.
 - IV. Claims 11-12 and 25-26, drawn to germ cells and a method of using said cells, classified in class 435, subclass 325.
 - V. Claims 13-14, 32, and 35-36, drawn to a cell culture medium and methods of screening factors for said medium, classified in class 435, subclass 404.
 - VI. Claim 29, drawn to a method of screening for a cell which can be promoted to become an embryonic stem cell, classified in class 435, subclass 377.
 - VII. Claims 33-34, drawn to a method of obtaining cells for therapy, classified in class 424, subclass 93.1+.
2. The inventions are distinct, each from the other because of the following reasons:

Art Unit: 1633

3. Inventions I and II are related because the invention of group II could be used in the making of the invention of group I. However, the invention of group II, primordial germ cells, is a separate and distinct product which has other recognized uses in the art, such as to make cell lines of specific lineages. Therefore, the two products are separably patentable.

4. Inventions I and III are related because the invention of group III could be used in the making of the invention of group I. However, the invention of group III, embryonic ectoderm cells, is a separate and distinct product which has other recognized uses in the art, such as to make cell lines of specific lineages derived from the ectoderm. Therefore, the two products are separably patentable.

5. Inventions I and IV are related because the invention of group IV could be used in the making of the invention of group I. However, the invention of group IV, germ cells, is a separate and distinct product which has other recognized uses in the art, such as to make offspring. Therefore, the two products are separably patentable.

6. Inventions I and V are related because the invention of group V can be used to sustain the invention of group I. However, the invention of group V could also be used to sustain other cells types. Therefore the two products are separably patentable.

7. Inventions I and VI are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the

Art Unit: 1633

product, the embryonic stem cells, can be made in other processes such as that claimed in claims 15-17.

8. Inventions I and VII are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the product, the embryonic stem cells, can be used in a materially different process, such as that claimed in claims 30-31.

9. Inventions II and III are related because either may be used to produce an embryonic stem cell. However, the inventions are directed to separate and distinct products which can be made and used without the other.

10. Inventions II and IV are related because either may be used to produce an embryonic stem cell. However, the inventions are directed to separate and distinct products which can be made and used without the other.

11. Inventions II and V are related because the invention of group V can be used to sustain the invention of group II. However, the invention of group V could also be used to sustain other cells types. Therefore the two products are separably patentable.

12. Inventions II and VI are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product

Art Unit: 1633

as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the process for using can be practiced with another materially different products, such as with any other embryonic cell type.

13. Inventions II and VII are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the process of using can be practiced with another materially different product such as the cells of group I, as is claimed.

14. Inventions III and IV are related because either may be used to produce an embryonic stem cell. However, the inventions are directed to separate and distinct products which can be made and used without the other.

15. Inventions III and V are related because the invention of group V can be used to sustain the invention of group II. However, the invention of group V could also be used to sustain other cells types. Therefore the two products are separably patentable.

16. Inventions III and VI are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP

Art Unit: 1633

§ 806.05(h)). In the instant case the process for using can be practiced with another materially different products, such as with any other embryonic cell type.

17. Inventions III and VII are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP

§ 806.05(h)). In the instant case the process of using can be practiced with another materially different product such as the cells of group I, as is claimed.

18. Inventions IV and VI are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP

§ 806.05(h)). In the instant case the process for using can be practiced with another materially different products, such as with any other embryonic cell type.

19. Inventions IV and VII are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP

§ 806.05(h)). In the instant case the process of using can be practiced with another materially different product such as the cells of group I, as is claimed.

Art Unit: 1633

20. Inventions V and VI are related as the invention of group V may be used to sustain the cells used in the method of invention VI. However, other mediums may be used and the cells sustained in the medium of invention V may not necessarily be used in the method of invention VI. Therefore, the inventions are separably patentable.

21. Inventions V and VII are related as the invention of group V may be used to sustain the cells used in the method of invention VII. However, other mediums may be used and the cells sustained in the medium of invention V may not necessarily be used in the method of invention VII. Therefore, the inventions are separably patentable.

22. Inventions VI and VII are related as the same cells may be used in either method. However, the methods of using the cells are separate and distinct. Either may be practiced without the other.

23. Because these inventions are distinct for the reasons given above, and groups I-IV have acquired a separate status in the art from groups V-VII as shown by their different classification, and the search required for either of groups I-VII is not required for any of the other groups, restriction for examination purposes as indicated is proper.

24. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Art Unit: 1633

25. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Deborah Clark whose telephone number is (703) 305-4051. The examiner can normally be reached on Mondays-Fridays from 7:10 a.m. EST to 3:40 p.m. EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brian Stanton, can be reached on (703) 308-2801. The fax phone number for the organization where this application or proceeding is assigned is (703) 308-4242.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.

DRC

01/20/99

Deborah Clark
AU 1633